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member discourages mouse movement off the edge of the pad. The Examiner lastly asserts that sports themes are indicated.

1.) Gillespie teaches only members that are a mouse "enclosure."

While Gillespie has members protruding from the pad, Gillespie teaches ONLY members which comprise an "enclosure" for a computer mouse. Gillespie essentially teaches a mouse-house. In all embodiments, Gillespie requires an "enclosure" which "exceeds the size of the computer pointing device." Gillespie requires an "internal area" inside the enclosure that can hold a mouse. Gillespie even states that the size of the enclosure is "such that the mouse is fully insertable into the internal area of the enclosure." In Gillespie, the mouse is meant to be put inside of the decorative structure and not used.

The common definition of the term "enclosure" denotes "confining" or "surrounding" (see, e.g., Merriam-Webster dictionary) *within the confines of the structure itself*. The mouse, while inside the enclosure, cannot be used; the mouse may logically be prevented from moving off the edge of the pad while in the enclosure, *but it is also not usable while inside the enclosure*.

2.) Gillespie teaches only "decorative" alterations to a mousepad.

Gillespie does not teach any functional aspects. The only 'functions' of Gillespie's decorations are to "personalize" a computer, and "stimulate [] interest in computing" and "make computing fun."

3.) Gillespie does not teach a barrier or bumper function.

Notwithstanding the Examiner's assertion, Gillespie contains no mention of a bumper or barrier function in his protruding "enclosure." There is nothing to indicate that Gillespie's enclosure was attached so as to provide a barrier function. Rather, Gillespie's enclosure is merely "decorative."

There is no teaching that Gillespie's mouse-house can provide a barrier to mouse movement; Gillespie's mouse-house could become easily dislodged if hit by a mouse.

4.) Gillespie teaches only surface mounting of his "enclosure."

Gillespie only teaches 'frictional' *surface* mounting, or the use of "adhesive tape" or "adhesive glue" for his mouse-house. Gillespie never teaches or addresses the need for his "enclosure" to resist repeated bumping by a mouse, lest the "enclosure" break off. This is because Gillespie's "enclosure" is merely "decorative."

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5.) Gillespie does not teach the use of a mousepad as an advertising or promotional device.

Gillespie does not teach or mention advertising or promotion in his disclosure. The Examiner acknowledged this.

6.) Gillespie does not teach the use of a mousepad as a game or as a sport in miniature.

Gillespie mentions the word "sports" twice in his disclosure: at a maximum, it teaches the use of sports-themed "decorative enclosures" with "artistic indicia." Further, Gillespie mentions only "indicia relating to baseball" and "football," and no other "sports." Moreover, Gillespie mentions only that his "mouse pals" figurines (his item #16) may be used in a game, without referring to the rest of the "array," and without mentioning the mousepad or teaching any specifics regarding the mousepad members. There is no teaching that the mousepad itself could serve as the game or for play of a sport, nor is there any teaching with respect to other sports or how they might be played using Gillespie's "array."

There is no suggestion or teaching of having a goalpost or flagpole or goal on the mousepad. There is no teaching that the mousepad or mouse-house have any particular football or sports "indicia," as opposed to having this "indicia" elsewhere in the "array." Moreover, Gillespie does not disclose what "indicia relating to" sports might be.

B.) CLAIMS 1, 8, 10, 11, & 14:

1.) Claims 1, 8, and 10 (and therefore Claims 2-9, and 13):

a.) Gillespie's mouse-house was not meant to provide a barrier, in contrast to the present disclosure.

The present disclosure has a specific limitation that the protruding members are *meant* to provide a barrier or bumper to discourage mouse movement off the edge of the mousepad. This limitation does not exist in Gillespie; there is no mention or contemplation of creating a mousepad barrier or bumper in his patent. The *placement*, *construction*, and *anchoring* of members to be used as a barrier or bumper are all novel limitations not taught by Gillespie. Each of these novel limitations appear throughout the present application and are present in all the drawings and discussed in the specification. Again, Gillespie teaches only "decorative" "enclosures" on his mousepad, without mention of the function of the mouse-house, other than appearance and a place to put a mouse into.

Gillespie's mouse-house is quite distinct from "providing a barrier to discourage mouse movement off the edge" of the mousepad *while the mouse is being used*. The present

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application specifically contemplates preventing movement off the edge of the pad *while the mouse is in use, rather than inside some structure.*

b.) Gillespie's mouse-house uses only surface-mounting.

Gillespie specifically teaches surface-mounting for his mouse-house, while the present application teaches mounting pegs or posts *into* the material of the mousepad (see, e.g., paragraph 46).

Further, the present disclosure further teaches not only the use of members that are anchored into the flexible material of the pad, but also teaches the use of different shapes of members and small alterations in the anchored sections of the members, such as the addition of "small circular section[s] ... to help anchor the bumper piece in the pad" (see, e.g., paragraphs 57 through 60).

Claims 1 and 10 have been amended to clarify that the protruding members are not merely surface-mounted, consistent with the application's disclosure.

Equating Gillespie's decorative mouse-house with a member meant to be a barrier or bumper is as illogical as equating a parked car with a cement street curb: both a street curb and a parked car stop other cars from traveling onto the sidewalk, but only the curb was designed with such functionality in mind.

Even if Gillespie could be said to suggest a bumper function, the present disclosure provides a novel improvement to the prior art, not anticipated by Gillespie.

2.) Claim 8:

Claim 8 has the specific limitations of having the member be in the shape of a football goalpost and the mousepad resembling a football field in full or in part. There is no mention or contemplation of creating a mousepad with these limitations in Gillespie. Gillespie merely mentions that *a part of his entire "array"* might contain "elements" with "a sports theme with artistic indicia *relating to ...* football." In fact, since Gillespie teaches only a mouse-house "enclosure" on the mousepad, it is novel and an improvement on the prior art to place a goalpost on the mousepad, rather than a mouse-house enclosure.

3.) Claim 10:

Claim 10 contains a specific limitation of requiring a raised member on the periphery of a mousepad. There is no mention of a placement requirement anywhere in Gillespie. This limitation goes back to the function of the member: providing a barrier against moving a mouse off the pad while in use. This particular limitation is novel and an improvement on the prior art.

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4.) Claim 11:

Claim 11 contains multiple limitations which are not taught in Gillespie, such as a mousepad resembling a playing surface of a sport and miniature accessories for use in playing the sport. This is not suggested or taught by Gillespie, and hence not anticipated by Gillespie.

Further, the present application teaches the possibility of using the mousepad as a game (see, e.g., paragraphs 53 through 56), or adding additional pieces that could be utilized to play a sport in miniature, using the mousepad.

These elements are novel and reveal an improvement over the prior art.

5.) Claim 14:

Claim 14 contains a limitation not taught or existing within Gillespie: improvements to a mousepad that can be used with an optical-type mouse. An optical-style mouse is different from a normal mouse; this type of mouse was never mentioned or contemplated by Gillespie.

C. THE TEACHINGS OF THE "INFORMATION FAIRWAY MOUSEPAD":

The Examiner asserts that the non-patent literature showing a picture, entitled an "Information Fairway Mousepad," teaches a mousepad with one or more connectedly attached members at or near the edge of the mousepad, attached in a roughly perpendicular fashion. Secondly, the examiner asserts that the picture shows a member that provides a barrier to discourage mouse movement off that edge of the pad. The Examiner also asserts that the picture appears to show a golf hole, post, and flag, with the appearance of a partial or full golf green. Lastly, the Examiner asserts that the flag provides area for promotional graphics.

1.) It is unclear whether the reference predates the filing of this application.

In order to make a rejection under § 102(b), the printed publication must have been made or the item sold, or the item in public use, more than one year prior to this application. It is not clear when the Information Fairway Mousepad was first advertised or sold. In order to make a prima facie case of § 102(b) anticipation, the Examiner needs to demonstrate a reasonable basis for the assertion that the relied-upon material pre-dates the present application.

2.) The item pictured does not teach a hole on the golf green.

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Regardless of the date of the publication of the Information Fairway Mousepad advertisement, there is no indication or teaching of a hole on the golf "green" either at the base of the flagpole or elsewhere on the "green."

D.) CLAIMS 1, 6, 7, & 12:

1.) Claim 1:

There is no indication as to how the "Information Fairway Mousepad's" flagpole is attached to the mousepad. There is no indication that the flagpole is sunk into the material of the pad.

There is no indication that the flagpole could be used to provide a barrier to the mouse, which is a limitation in the present disclosure. If the flagpole in the Information Fairway Mousepad is decorative, like the enclosure in Gillespie, the flagpole could become dislodged if struck by a mouse. This would not serve the expressed purpose of the present disclosure.

As noted above, Claim 1 has been amended to clarify that the present application discloses members which are anchored into the mousepad. The limitations present in the present disclosure make it novel over the Information Fairway Mousepad.

2.) Claims 6 and 7:

Claims 6 and 7 have a specific limitation not present in the picture: the claims specifically state that the mousepad have a something resembling a "golf hole." The item the Examiner relies upon has no indication of a hole. On a golf course, the flagpole is inserted into the center of the hole and a golf ball can fit into the hole while the flagpole is still placed in the hole. This requires that the area around the flagpole be wider than the flagpole itself. In addition to being stated specifically in Claims 6 and 7, this limitation is very clear on the drawings in the present application (see, also, paragraph 67). On the contrary, the flagpole in the Information Fairway Mousepad appears to have no area at its base wider than the width of the flagpole, and, hence, no hole.

The presence of a hole is, at the very least, a novel improvement to the Information Fairway Mousepad in that it is more realistic and provides the other functionality discussed above, such as the game-playing functionality and anchoring for the bumper functionality.

3.) Claim 12:

Claim 12 has been amended to clarify, consistent with the original disclosure, that the shape and markings of the mousepad and the appearance of the protruding members resemble a sporting area.

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The present application teaches the use of corporate logos, signatures, or other graphics for advertising or promotional purposes (see, e.g., paragraphs 48, 49 & 52), hence the use of the word "promotional" in Claim 12. These graphics can be located on the surface of the mousepad itself, rather than solely on a golf-flag. There is no indication that the Information Fairway Mousepad can be created with advertising graphics elsewhere, other than on the golf-flag. The use of graphics other than on the golf-flag is not an element taught by the Information Fairway Mousepad publication.

Further, the Information Fairway Mousepad does not teach the use of mousepads that resemble any sport other than golf.

The use of graphics on areas of the mousepad and mousepads that resemble sports other than golf represent novel improvements over the prior art, not anticipated by the Information Fairway Mousepad.

II. CLAIM REJECTION - 35 U.S.C. § 103

The Examiner is required to show one or more references that teach a suggestion to combine or modify the references, making the present claims obvious. The combination in turn must teach or suggest all the claim limitations.

The Applicant reiterates his prior-stated arguments, above.

A.) CLAIMS 2 AND 4 AND THE TEACHINGS OF GILLESPIE:

The Examiner asserts that Gillespie teaches a mousepad with connectedly attached members and asserts that, while only a tropical theme is shown in the Gillespie disclosure, sports themes of baseball and football are encouraged. The Examiner accepts that Gillespie fails to teach sports themes of hockey or basketball, but asserts that these are merely an obvious matter of design choice.

1.) Gillespie teaches away from the use of goalposts or goals attached to the mousepad.

There is no indication or mention or suggestion in Gillespie that the mousepad or attached members actually resemble any sport playing field at all. Quite the contrary, Gillespie, while it may indicate the use of a sports "theme," Gillespie teaches the use of an array *used over the entire computer*, with attachments all around the computer, keyboard, and mousepad, as well as specific limitations on the appearance and construction of the mousepad: the mousepad must have an "enclosure" or mouse-house for the mouse *to be placed inside of*.

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While Gillespie could, arguably, teach the use of, say, a race car garage, it teaches away from goals used in common sports, such as basketball or football by requiring an enclosure for the mouse to be placed into.

Turning to the present disclosure, the drawings and specification teach realistically shaped goals that would not provide an enclosure for a mouse. Claim 2 provides the specific limitation of having a member "in the shape of a hockey goal." A hockey goal cannot "enclose" a mouse. Claim 4 provides the specific limitations of member "in the shape of a basketball pose, backboard, and hoop." A basketball goal provides no enclosure for a mouse. Clearly, there is no enclosure in the present application for the mouse, thus, Gillespie teaches away from the present disclosure.

The use of simulated hockey or basketball goals are not obvious from Gillespie.

2.) Gillespie does not suggest a mousepad that could be used to play a sport in miniature.

While Gillespie indicates the possibility of having a "sports theme" with "artistic indicia relating to baseball or football," he makes no reference to the mousepad or mouse-house itself or in particular. His disclosure is silent as to how a mousepad might look or function as part of a larger sports-themed "array." There is no suggestion from Gillespie that the mousepad itself or by itself could be used to play any game or sport in miniature.

The disclosure of Gillespie suggests an array that makes the use of the computer itself more enticing to children. There is no suggestion that the mousepad and its attachments could be used by itself--without even the presence of the mouse or the computer--to play a sport.

The ability of the present disclosure to be used to play a facsimile of a sport in miniature is an outgrowth of the limitation of having miniature goals on the mousepad, a non-obvious improvement over the prior art.

3.) Gillespie does not teach members which are anchored in a mousepad.

Since both Claims 2 and 4 are dependent claims stemming from Claim 1, the limitations inherent in Claim 1 also limit Claims 2 and 4. Applicant has amended Claim 1 in this response.

As noted previously, Gillespie teaches away from anchoring members into the mousepad. Gillespie specifically teaches surface mounting of members. As such, Gillespie also fails to teach or suggest hockey or basketball goals which act as barriers to mouse movement.

For these reasons, Gillespie fails to teach or suggest elements which make the present claims obvious. In and of itself, Gillespie fails to suggest all of the present claim limitations. As such, Gillespie cannot provide a prima facie basis for a § 103 rejection.

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B. CLAIMS 3, 5, AND 9, AND THE TEACHINGS OF GILLESPIE, IN CONJUNCTION WITH DEPIERO.

The Examiner admits that Gillespie does not teach the use of text or graphics on the mousepad or attachment, to be used for promotional purposes. However, the Examiner asserts that Depiero (US Patent 5,952,070) utilizes graphics for informational purposes and it would have been obvious to combine these references.

1.) Depiero teaches away from the use of silk-screening or printing directly on the mousepad.

Depiero teaches a way of creating a *new type of mousepad* with advertising indicia on it. Depiero requires the use of a clear Lexan sheet with a clear adhesive layer underneath. Depiero's mousepad is specifically meant to teach away from the common mousepad, and away from the use of common mousepad materials.

Specifically, Depiero states that the common mousepad construction is "relatively expensive and relatively bulky" and carries "a significant cost." This teaches away from the common mousepad construction used in the present disclosure, and Gillespie. It also specifically teaches the use of a very particular mousepad material: G.E. manufactured Lexan, with the "designation 8B35 VelvetMat" of a specific thickness: 0.01 inch.

As such, the delivery or carrier of the promotional indicia in Depiero is so mated to the disclosure as to teach away from the present invention. There is no suggestion of combining Depiero's disclosure with the common mousepad material, just the opposite: common mousepad material is eschewed.

With respect to Gillespie, there is no possibility of combining Gillespie's teaching of a mousepad with posts with Depiero's concept of using a thin Lexan sheet. This combination is not feasible. Gillespie requires a mousepad of sufficient thickness so that the posts and the enclosure can be attached. Thus, Depiero teaches away from a combination with Gillespie.

The present disclosure teaches the use of connectedly attached members protruding from the mousepad. Depiero's thin, adhesive, Lexan sheet could not support these members.

The Examiner must put forth a reasonable expectation of success in the combination of references (see MPEP 706.02(j)). However, in this case, the Examiner's proposed combination makes Depiero and Gillespie inoperable for either of their intended purposes. The resulting inoperable art teaches away from the proposed combination and is, thus, a reflection of non-obviousness for the present disclosure.

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C.) CLAIM 13 AND THE TEACHINGS OF GILLESPIE, IN CONJUNCTION WITH MURPHY

The Examiner asserts that Gillespie teaches Claim 1 and, in conjunction with Murphy (US Patent # 5,876,010), the combination teaches a mousepad that can be written on.

1.) Murphy specifically teaches the incorporation of a writing tablet and a mousepad, and teaches away from a mousepad which can, in and of itself, be written on.

Murphy specifically requires the use of separate sheets of paper ("a plurality of sheets of paper"), attached together. Further, Murphy specifically requires that each and every sheet of paper have imprinted upon it some type of texturing. The required texturing ("micro-dome bumps") is used to increase the "coefficient of friction necessary to continuously contact the track ball of a computer mouse as it moves across the same, without any irregularities or spaces" while providing an "easy or smooth to write[-on]" surface.

Gillespie, as already discussed, above, teaches surface-mounting of posts used to attach a mouse-house.

There is no suggestion to combine these references into one invention. In fact, Murphy's requirement of multiple sheets of paper and Gillespie's teaching of surface-mounted posts suggests or teaches only that Gillespie's mouse-house would come off when the first sheet of paper was used and removed. It is also hard to imagine how a piece of paper from Murphy's invention would hold the post necessary to attach Gillespie's mouse-house. This combination is inoperable.

Moreover, Murphy's intended benefit is to have multiple sheets of paper which can be torn off. Any structure on top of a pad of paper prevents sheets from being torn off.

As noted previously, the Examiner must delineate a reasonable expectation of success in the combination of references. In this case, the Examiner's proposed combination makes Murphy and Gillespie inoperable for either of their intended purposes. The resulting inoperable art teaches away from the proposed combination and is, thus, a reflection of non-obviousness for the present disclosure.

Moreover, the present invention contemplates a mousepad with a porous surface for writing upon. Murphy teaches away from this simplicity. While Murphy requires multiple sheets of paper and requires paper with a manufactured textured surface, the present invention requires only one porous surface. Murphy, through its complexity, teaches away from the present invention.

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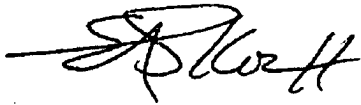
III. CLAIM OBJECTIONS

The Examiner recommended amending all claims, so that they read "a mousepad" rather than "an improved mousepad." These amendments were made herein.

C. CONCLUSION

For the reasons stated above, the Applicant asks that the Examiner enter the amendments contained herein, withdraw her rejections with respect to the claims, and allow the application to issue as a patent.

Thank you,
Sincerely,

A handwritten signature in black ink, appearing to read "Ed Skoch", with a stylized flourish at the end.

Ed Skoch